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09 401,004	09 21 1999	HENGYUAN LANG	P-HP-3589	4060

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EXAMINER

GARCIA, MAURIE E

ART UNIT	PAPER NUMBER
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1627

DATE MAILED: 04 24 2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/401,004

Applicant(s)
Lang et al

Examiner
Maurie E. Garcia, Ph. D.

Art Unit
1627



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jan 29, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-41 is/are pending in the application.
- 4a) Of the above, claim(s) 23, 24, 27-34, and 41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-22, 25, 26, and 35-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirements.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) approved b) disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) Interview Summary (PTO-413) Paper No(s) _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) Notice of Informal Patent Application (PTO 152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 20) Other _____

DETAILED ACTION

Please note the change in examiner.

1. The Response filed January 29, 2002 (Paper No. 17) is acknowledged. Claims 16, 17 and 22 were amended, claims 35-41 were added and claims 1-15 were cancelled. Therefore, claims 16-41 are pending.

Election/Restriction

2. Applicant's election with traverse was discussed in the last Office Action and was made FINAL by the previous examiner. The election of species was also acknowledged.

3. There was an error made by the previous examiner with respect to the claims that read on the elected species and those that are withdrawn from consideration. Withdrawn claim 25 should have been examined in the last action as it reads on the elected species. Thus, the originally filed claims reading on the elected species are 16-22, 25 and 26. Claims 23, 24 and 27-30 remain withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to non-elected species, the requirement having been traversed in Paper No. 14.

4. Due to the omission of claim 25 from the rejections in the previous action, this application remains in non-final status.

5. Applicant argues in the instant Response that claims 23-25 and 27-30 should have been examined (Response, page 34) because applicant's specifically elected species was searched and was not found in the prior art. Claim 25 is discussed above. Claims 23, 24 and 27-30 *remain* withdrawn from consideration. Please see MPEP § 803.02 (emphasis added):

On the other hand, *should no prior art be found that anticipates or renders obvious the elected species, the search of the Markush-type claim will be extended. If prior art is then found that anticipates or renders obvious the Markush-type claim with respect to a nonelected species, the Markush-type claim shall be rejected and claims to the nonelected species held withdrawn from further consideration. The prior art search, however, will not be extended unnecessarily to cover all nonelected species.* Should applicant, in response to this rejection of the Markush-type claim, overcome the rejection, as by amending the Markush-type claim to exclude the species anticipated or rendered obvious by the prior art, the amended Markush-type claim will be reexamined. The prior art search will be extended to the extent necessary to determine patentability of the Markush-type claim. In the event prior art is found during the reexamination that anticipates or renders obvious the amended Markush-type claim, the claim will be rejected and the action made final. Amendments submitted after the final rejection further restricting the scope of the claim may be denied entry.

6. Also, newly added claim 41 does not read on the elected species. The elected species has $R^6 = \text{methylmethylene}$ (which was previously interpreted as $-\text{CH}_2\text{CH}_2-$; also see further discussion in paragraph 12 below). This election does not encompass a moiety where W must be present (as required in claim 41). Thus, claim 41 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to non-elected species.

7. Lastly, applicant argues that claims 31-34 directed to methods of making single compounds should be rejoined with the product claims as per MPEP 821.04 (Response, page 34-35). However, this provision only takes effect when a product claim is found to

be allowable. No claims are deemed to be allowable. Also, rejoinder is only appropriate when the scope of the product and process claims is identical; note the following:

Pursuant to the procedures set forth in the Official Gazette notice dated March 26, 1996 (1184 O.G. 86), claims directed to the process of making or using a patentable product, previously withdrawn from consideration as a result of a restriction requirement would be subject to being rejoined at such time as the product becomes allowable. Note that process claims which do not depend from or otherwise include *all the limitations of the allowable product* will not be subject to being rejoined.

Therefore, claims 31-34 remain withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

8. Newly added claims 35-40 read on the elected species and are included in the examination. Thus, claims 16-22, 25, 26 and 35-40 are examined on the merits in this action.

Response to Arguments and Amendments

9. The previous objections and rejections under 35 USC 112 are withdrawn in view of applicant's amendments and arguments. The rejection over WO 97/10219 is withdrawn in view of applicant's amendments to the claims.

10. It is noted that applicant is correct in asserting that the WO 99/40072 reference is **not** a reference under 35 USC 102(b) (Response, pages 41-42). This reference qualifies as prior art under 35 USC 102(a). The Declaration filed on January 29, 2002 under 37 CFR 1.131 is sufficient to overcome the WO 99/40072 reference.

Claim Rejections - 35 USC § 112

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claim 26 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim uses terms such as “methylnethylene”. This creates confusion as it is unclear as to applicant’s intent. The claim also recites “ethylene”; are these meant to indicate the same moiety? Furthermore, “methylnethylene” is not standard terminology in the organic chemistry art. While applicant may be his or her own lexicographer, a term in a claim may not be given a meaning repugnant to the usual meaning of that term. See *In re Hill*, 161 F.2d 367, 73 USPQ 482 (CCPA 1947).

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(c) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

14. Claims 16, 17, 19, 20, 25 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Kenney et al (US 5,300,420).

Kenney et al disclose compounds that read on those claimed. Specifically see column 7 of the reference where 6 different compounds (Compounds 1-6) are disclosed that read on those of the instant claims. The compounds of Kenney et al read on the claims when $R^1 - R^5$ of the claims are H; $R^6 = -CH_2CH_2-$; (D = alkylene and W & E absent); and R^7 and R^8 are H, alkyl and/or substituted alkyl (substituent is cyano).

15. Claims 16, 17, 19-22, 25 and 35 are rejected under 35 U.S.C. 102(e or b) as being anticipated by Miyachi et al (US 5,932,607 and corresponding PCT WO 95/15951).

It is noted that US patent 5,932,607 is an English language equivalent of PCT WO 95/15951. Although the PCT is on Japanese, the teachings with respect to the specific compound taught are evident from the structures depicted therein and the English language Abstract. See Example 16 in the Table on page 14 of WO 95/15951, which corresponds exactly to Example 16 in Table 2 of US patent 5,932,607. US 5,932,607 has a date that qualifies the patent as a 102(e) reference and PCT WO 95/15951 has a date that qualifies a 102(b) reference.

Miyachi et al disclose a compound that reads on those claimed. See Example 16 in Table 2 where a compound reading on those of the claims is specifically disclosed. This compound reads on the instant claims when $R^1 - R^5$

of the claims are H; R⁶ = substituted C3 alkylene (D = substituted alkylene and W & E absent; substituents are phenyl); and R⁷ and R⁸ are H.

16. Claims 16-22, 25 and 35-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Girten et al (US 6,284,735).

Girten et al disclose compounds that read directly on those claimed. See Compounds A to D as disclosed in columns 8 (beginning on line 37) through 9 where four compounds reading on those of the claims are specifically shown. These compounds read on the instant claims when R¹, R² and R⁴ of the claims are H; R⁶ = substituted methylene (D = substituted alkylene and W & E absent; substituents are substituted alkyl); and R⁷ and R⁸ are H. The compounds of Girten et al read on the instant R³ group when it is -(C)ONR¹¹R¹², with R¹¹ and R¹² = H and/or substituted alkyl (substituents are phenyl). Furthermore, these compounds are substituted at the instant R⁵ position with substituted phenyl groups, reading on the instant claims.

Status of Claims/Conclusion

17. No claims are allowed. However, claim 26 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

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18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maurie E. Garcia, Ph.D. whose telephone number is (703) 308-0065. The examiner can normally be reached on Monday-Thursday from 9:00 to 6:30 and alternate Fridays.

19. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jyothsna Venkat, can be reached on (703) 308-2439. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.



MAURIE E. GARCIA, PH.D.
PATENT EXAMINER

Maurie E. Garcia, Ph.D.
April 12, 2002